IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Mark W. Brockman et al.	§	Art Unit:	3673
Serial No.:	10/701,325	§		
		§	Examiner:	John J. Kreck
Filed:	November 4, 2003	§		
For:	Inductively Coupled Method and Apparatus of Communicating with Wellbore Equipment	§	Atty. Dkt. No.:	SHL.0152D1US (68.0114CIP/DIV)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

Claim 1 was rejected as being obvious over the asserted combination of Tubel and More. It is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness against claim 1, as there existed no motivation or suggestion to combine the teachings of Tubel and More to achieve the claimed invention. *See* M.P.E.P. § 2143 (8th ed., Rev. 2), at 2100-129.

Claim 1 recites an apparatus for use in a well having a main bore and a lateral branch, the lateral branch comprising an electrical device, and the apparatus comprising an inductive coupler mechanism to electrically communicate electrical signaling in the main bore with the electrical device in the lateral branch.

Date of Deposit: September 8, 2005

I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313.

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As conceded by the Examiner, Tubel fails to teach the inductive coupler mechanism recited in claim 1. 6/10/2005 Office Action at 2. The Examiner relied upon More as teaching such an inductive coupler mechanism. *Id.* at 3. However, the Examiner has failed to establish that there existed any motivation or suggestion to combine the teachings of Tubel and More. The Examiner cited two cases as purportedly supporting the obviousness rejection: *In re Fine,* 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). *See* 6/10/2005 Office Action at 7. It is respectfully submitted that these cases clearly do not support the obviousness rejection. *In re Jones* holds that "[b]efore the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." *In re Jones,* 958 F.2d at 351. In *In re Jones*, the court stated that the PTO failed to cite to any objective evidence that provided the motivation to modify the teachings of the prior art references to achieve the claimed invention, and thus held that the PTO failed to establish a *prima facie* case of obviousness. *Id.* Similarly, *In re Fine* held that the PTO can satisfy the burden required to establish a *prima facie* case of obviousness "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine,* 837 F.2d at 1074. Specifically, the court in *In re Fine* criticized the PTO's use of impermissible hindsight in reaching the obviousness rejection. *Id.* at 1075. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.*

Note that More teaches use of an inductive coupler mechanism to couple components inside a main wellbore -- there is no suggestion whatsoever in More of using the same technique to connect between a main wellbore and a lateral branch. Although Tubel teaches electrical communication between the main wellbore and a lateral branch, it does not suggest that an inductive coupler mechanism can be used to electrically communicate electrical signaling in the main bore with the electrical device in the lateral branch. Significantly, although Tubel mentions the use of an inductive coupler, Tubel mentions the use of the inductive coupler in a side pocket mandrel depicted in Fig. 8 of Tubel. Thus, although Tubel was *aware* that inductive couplers were available as a technique for communicating, Tubel specifically did *not* suggest that such an

inductive coupler can be used to communicate electrical signaling in the main bore with an electrical device in the lateral branch. This is significant objective evidence establishing that a person of ordinary skill in the art prior at the time of the present invention did not contemplate the use of an inductive coupler to connect main bore electrical signaling to lateral branch devices. The only suggestion of the claimed combination is provided by the disclosure of the present application itself -- however, the obviousness rejection of claim 1 cannot be based on impermissible hindsight that benefits from the teachings of the present application. *See In re Fine*, 837 at 1075 ("It is essential that 'the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made ... to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.'").

Objectively, looking to the teachings of Tubel and More, a person of ordinary skill in the art would not have been motivated to combine their teachings. Electrically coupling components in a main wellbore and lateral branch is associated with challenges that are not present in coupling components within a main wellbore. Neither Tubel nor More suggests the use of an inductive coupler mechanism to address these challenges.

Therefore, clear legal error has been committed in rejecting claim 1 over Tubel and More, since a *prima facie* case of obviousness has clearly not been established with respect to claim 1.

Independent claim 2 recites a connector mechanism to connect equipment in a main bore to equipment in a lateral branch, and a first inductive coupler portion attached to the connector mechanism to communicate electrical signaling with the lateral branch equipment. As noted above, there is no motivation to combine Tubel and More to achieve the recited subject matter. Furthermore, even if Tubel and More can be properly combined, there is no teaching or suggestion by the hypothetical combination of Tubel and More of a first inductive coupler portion *attached to the connector mechanism* to communicate electrical signaling with the lateral branch equipment.

In response to the arguments presented above, the Examiner stated that this argument "is not at all persuasive" and that "[e]verything in the wells shown by Tubel and More are 'attached'; thus one of ordinary skill in the art would know to make any modification 'attached': to do otherwise would result in the components being swept along the flow, lost, or damaged." 6/10/2005 Office Action at 7.

Applicant respectfully disagrees with this assessment. Claim 2 specifically states that the first inductive coupler portion is attached to the connector mechanism, which is used to connect equipment in the main bore to equipment in the lateral branch. There is no teaching or suggestion in either Tubel or More of attaching an inductive coupler portion to the connector mechanism. Note that Tubel teaches providing an inductive coupler portion in a side pocket mandrel (see Fig. 8 of Tubel). More teaches attaching inductive coupler portions at a wellhead and also to downhole tubing in the main bore – More does not teach attaching an inductive coupler portion to a connector mechanism as recited in claim 2. Thus, although Applicant agrees with the Examiner that an inductive coupler portion would typically be attached to some structure in a well, there is no teaching or suggestion in either Tubel or More of attaching an inductive coupler portion to a connector mechanism adapted to connect equipment in the main bore to equipment in the lateral branch.

Therefore, a *prima facie* case of obviousness has not been established with respect to claim 2. Dependent claims of claim 2 are allowable for at least the same reasons.

With respect to independent claim 8, there existed no motivation or suggestion to combine the teachings of Tubel and More to achieve a completion string that includes equipment in the main bore and in the lateral branch, a first inductive coupler assembly proximal the equipment in the main bore, and a second inductive coupler assembly proximal the equipment in the lateral branch, and an electrical cable connecting the first and second inductive coupler assemblies. Tubel fails to teach or suggest first and second inductive coupler assemblies, and More fails to teach or suggest the second inductive coupler assembly proximal equipment in the lateral branch. No suggestion existed in either of the references to combine their teachings to achieve the claimed invention. Therefore, a *prima facie* case of obviousness has clearly not been established with respect to claim 8.

Independent claim 20 is also allowable over the asserted combination of Tubel and More, since no motivation or suggestion existed to combine the teachings of Tubel and More to achieve the provision of a first inductive coupler assembly electrically connected to main bore equipment and in communication with lateral branch equipment. A *prima facie* case of obviousness has therefore not been established with respect to claim 20.

For the foregoing reasons, it is respectfully requested that the final rejection be withdrawn and the present claims be allowed. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0152D1US).

Respectfully submitted,

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